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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			SU, EMILE	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			02/13/2009 ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/556,729

Applicant(s)

KIKKOJI ET AL.

Examiner

EMILE SU

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is in response to amendments filed on February 6, 2009.
2. Claims 1-11 are amended. Claims 12-14 are new.
3. **Claims 1-14** are currently pending. Claims 1-14 are rejected.

Examiner's Note

4. A telephone call was made to PRANAY PATTANI on February 9, 2009 to confirm the arguments from amendments filed on November 25, 2008 are to be considered in this Office Action response.

Response to Arguments

5. Applicant's arguments filed February 6, 2009 have been fully considered but they are not persuasive.
6. Applicant's arguments with respect to missing drawing reference in the description have been fully considered but they are not persuasive. Applicant indicated appearance of **Fig. 1, Reference 30** on page 14 of the original specification. However, page 14 of the specification is explaining elements of Fig. 2. There is no specific recitation indicating that network 30 of found in the description of Fig.2 is the same network 30 of that in Fig 1. Correction to clearly indicate what applicant regards as Fig. 1, Reference 30 is required. Objection to the drawing in the previous Office Action is maintained.

7. Applicant's arguments with respect to rejections to **Claims 2, 6, and 9** under 35 U.S.C. §112, second paragraph, have been fully considered but they are not persuasive. As to Claims 2 and 6, the phrase "a ring shaped buffer" is still unclear whether addressing physical shape or data structure. Rejection from the previous Office Action is maintained. As to Claim 9, rejection to the phrase "is receiving the contents" stated the previous Office Action is maintained as it is still unclear what is receiving the contents.
8. Applicant is of the opinion that the prior art does not teach "input recording request" [claim 1] features. Examiner respectfully disagrees. Specifically, the Levy reference teaches "the user actuates an input device to control the record process ... the user may hear a song that she likes and press record", see Column 14 of Levy. Therefore, the originally cited prior art continues to read on the claimed method and system.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 5-9 and 13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Concerning Claim 5, Applicant's method claim is non-statutory for failing the machine-or-transformation test. Based on Supreme Court precedent (see also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, in order for a method to be considered a

“process” under 35 U.S.C. §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, Claim 5 fails prong (1) because the claim is directed to metal steps and abstract ideas with no tie to another statutory class. Additionally, the claim fails prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

As to Claims 6-9 and 13, see discussion of Claim 5 above. These claims depend from Claim 5 and inherit the same deficiency of Claim 5.

Claim Rejections - 35 USC § 112, First Paragraph

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. **Claims 3 and 7** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Concerning Claim 3 and 7, Applicant recites “different buffer sizes” in the claim. The closest support for this limitation is found on Page 9 of the Specification stating “a recording time setting means⁷ for setting the recording time period of the broadcast information”. Furthermore, the disclosure of a buffer is found on Page 11 of the Specification stating “by ring buffer recording”. There is no mention of different buffer sizes in both instances. There is insufficient support in the original disclosure for this limitation in the claim.

Claim Rejections - 35 USC § 112, Second Paragraph

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. **Claims 3, 4, 6, 7, 8, and 9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 3 and 7, Applicant recites “modifying the specific time intervals to include different buffer sizes”. The claim is unclear how different buffer sizes are included under time intervals, as the former is a concept of size and the latter is a concept of size. The phrase will be understood as modifying buffer sizes for the purpose of prior art examination.

Regarding Claims 4 and 8, Applicant recites the phrase “the contents-related information” in fifth and eight line of the claim. It is unclear whether this phrase is referring to the first contents-related information or the second contents-related information found in Claim 1 and Claim 5. There is insufficient antecedent support for this limitation in the claim.

Regarding Claim 6, Applicant recites “in the memory” in the second of the claim. The previous recitation for this limitation can not be found. There is insufficient antecedent basis for this limitation in the claim.

As to Claim 7, see discussion of Claim 6 above.

Regarding Claim 9, Applicant amended the claim to positively recite “using a terminal apparatus, with an authentication server having an authentication function and a related information providing server providing the first and second contents-related information, and receiving the first contents”. The claim language, however, is unclear to one of ordinary skill in the art as the claim does not explicitly point out whether “a related information providing server” is part of the “authentication server” or an independent server by itself. See *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989). The

phrase will be understood as “related information providing server” being part of the “authentication server”.

Further regarding Claim 9, Applicant's amendment to add “first and second” in the fourth line of the claim introduces two related information. Applicant's later recitation of “the related information” in the twenty-third line of the claim is unclear whether it is referring to the first or second contents-related information. There is insufficient antecedent support for this limitation in the claim.

Claim Rejections - 35 USC § 103

15. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
16. **Claims 1, 5, 12, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy.

With respect to Claim 1, Poltorak discloses:

a receiver configured to receive first contents (i.e. receiver receives at least one of at least one of a transmission of media content and a broadcast of media content, see Poltorak, Abstract) from a broadcasting station (i.e. broadcast from a broadcasting system, see Poltorak, Column 2, Line 62 through Column 3, Line 3);

a temporary memory unit configured to temporarily store first contents-related information related to the first contents (i.e. memory device can contain ... name of the song, see Poltorak, Column 13, Lines 3-21);

a memory configured to store the first contents (i.e. memory device may also contain media content, see Poltorak, Column 13, Lines 22-24) and to store, the first contents-related information (i.e. memory device can contain ... name of the song, see Poltorak, Column 13, Lines 3-21); and

the memory being configured to store a plurality of second contents and a plurality of second contents-related information received from a server, the second contents-related information being related to the first contents (i.e. memory device can contain, see Poltorak, Column 13, Lines 3-24; mere duplication of storing information has no patentable significance unless new and unexpected results is produced, see *In re Harza*, 124 USPQ 378, (CCPA 1960)).

Poltorak also discloses the use of input device to control operation (i.e. input device, see Poltorak, Column 14, Lines 3-9), but does not specifically input recording request.

Levy does teach a user activated recording request (i.e. user actuates an input device to control the record process, see Levy, Column 14, Lines 43-58; also see Column 14, Line 34 through Column 15, Line 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Levy to create a recording apparatus that records and relates contents-related and broadcast information in response to an input, because the manual input of recording request increases user control over the recorded content.

As to Claims 5 and 12, see discussion of Claim 1 above.

As to Claim 13, see discussion of Claim 5 above.

17. **Claims 2 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Fiedler.

With respect to Claim 2, Poltorak and Levy disclose the invention substantially as claimed. Poltorak further discloses:

a broadcast information recording unit configured to record the first contents, in the memory, and to record the first contents before and after the input recording request (i.e. broadcasting system 10, see Poltorak, Column 12, Line 58 through Column 13, Line 2; also see Column 13, Lines 22-24; note claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone, see MPEP 2214; In re Swineheart, 169 USPQ 226; In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Poltorak and Levy do not specifically teach one to use circular buffer design to store information. Fiedler does discuss the use of circular buffer to record audio information before and after a request to record (see Fiedler, Column 3, Lines 31-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use circular buffer suggested by Fiedler in the recording apparatus of Poltorak to record information before and after a recording request, because circular buffer allows for more efficient operation by calculating only the necessary memory blocks.

As to Claim 6, see discussion above of Claim 2 above.

18. **Claims 3 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy and Fiedler as applied to Claims 2 and 6 above, and further in view of Chan.

With respect to Claim 3, Poltorak, Levy, and Fiedler disclose the invention substantially as claimed. Poltorak does not specifically teach one to use different buffer size. Chan discloses a research of caching scheme by adjusting the size of the buffer (see Chan, Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the size of the buffer in Poltorak as suggested by Chan, because different broadcast media require different buffer sizes.

As to Claim 7, see discussion above of Claim 3 above.

19. **Claims 4 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Kim.

With respect to Claim 4, Poltorak and Levy disclose the invention substantially as claimed. Poltorak further discloses the contents are correlated with the contents-related information (i.e. retrieve information which is stored in the memory or buffer regarding the respective song or album, see Poltorak, Column 17, Line 58 through Column 18, Line 9).

Poltorak does not specifically disclose a sound information synthesizing unit configured to synthesize sound information with the contents being received at a time when the recording request is input. Kim does teach a sound information synthesizing unit configured to synthesize sound information with the contents being received (i.e. sound generator 35 for generating a predetermined sound according to the displayed picture, see Kim, Column 3, Lines 25-50) at a time when the recording request is input (i.e. a point in time when an operation state is indicated for a user upon an input of a user, see Column 6, Lines 6-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add a sound output taught by Kim to a recording apparatus disclosed by Poltorak to notify the current state of the apparatus, because this provides audio feedback about the current operation.

As to Claim 8, see discussion of Claim 4 above.

20. **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claims 1 and 5 above, and further in view of Dujari.

With respect to Claim 9, Poltorak discloses the invention substantially as claimed.

Poltorak does not specifically disclose communicating, using a terminal apparatus, with an authentication server and a related information providing server. Dujari does teach communicating, using a client computer, with a login server and a participating server (i.e. third party authentication service, see Dujari, Column 6, Lines 46-61).

Poltorak does not specifically disclose a method of transmitting request information requesting to the related information providing server along with a service session ID between the terminal apparatus and the related information providing server. Dujari does teach sending an HTTP GET request to the participating server (i.e. HTTP GET, see Dujari, Column 7, Lines 25-34) along with a login server ticket between the computer client and the participating server (i.e. cookies indicating that the user is authenticated for future requests ... authentication service will include these additional cookies, see Dujari, Column 9, Lines 6-23).

Poltorak does not specifically disclose receiving, from the related information providing server, information indicating an authentication error and service identifying information for identifying the related information providing server. Dujari does teach a process of receiving an authentication error (i.e. responds with an authentication error, see Dujari, Column 19, Lines 33-45) and service identifying information for identifying the related information providing server (i.e. additional authentication related data, see Dujari, Column 7, Lines 35-48).

Poltorak does not specifically disclose transmitting authentication ticket issuance request information requesting issuance of an authentication ticket for accessing the related information providing server to the authentication server along with a session ID between the apparatus and authentication server. Dujari does teach transmitting ticket issuance request information requesting issuance of an authentication ticket for accessing the participating server (i.e. client 306 contacts the login server 308 to obtain the appropriate tickets, see Dujari, Column 8, Lines 55-62) along with a credentials between the client and login server (i.e. credential need to be provided, see Dujari, Column 8, Line 63 through Column 9, Line 5).

Poltorak does not specifically disclose a method of receiving authentication ticket from authentication server and transmitting authentication request information to related information providing server along with authentication ticket. Dujari does teach receiving authentication ticket from login server (i.e. login server 308 responds with the tickets required to access the server containing the originally requested resource, see Dujari, Column 8, Line 63 through Column 9, Line 5) and transmitting authentication request

information to participating server along with authentication ticket (i.e. tickets are included with future request to that server, such as in the redirected GET request, see Dujari, Column 9, Lines 6-24).

Poltorak does not specifically disclose receiving a service session ID between the apparatus and related information providing server if authenticated. Dujari does teach receiving a cookie between the client and participating server if authenticated (i.e. cookies indicating that the user is authenticating for future requests, see Dujari, Column 9, Lines 6-24).

Poltorak further discloses transmitting a request for related information (i.e. step 505, see Poltorak, Column 17, Line 52 through Column 8, Line 9), but does not specifically disclose transmitting along with a session ID. Dujari teaches transmitting a request along with cookies (i.e. cookies indicating that the user is authenticated for future requests ... authentication service will include these additional cookies, see Dujari, Column 9, Lines 6-23).

Poltorak also discloses receiving information that corresponds to related information request (i.e. step 512, see Poltorak, Column 18, Lines 44-55), but does not specifically disclose to be authenticated prior to receiving the information. Dujari teaches authenticated prior to receiving the resource (i.e. the server checks the request for the presence of tickets, see Dujari, Column 8, Lines 36-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include third party authentication as taught by Dujari in the system of Poltorak in view of Levy, since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to Claim 10, see discussion of Claim 9 above. Poltorak and Levy disclose the invention substantially as claimed.

Poltorak does not specifically disclose receiving an authentication error and transmitting a user ID and password to the authentication server. Dujari does teach using HTTP 401 code to response to an error and request for ID and password (i.e. HTTP 401, see Dujari, Column 8, Line 63 through Column 9, Line 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Poltorak in view of Dujari by using HTTP 401 status code to notify user of an error and prompt for user input, because this can prevent cryptanalysis using outdated information in cookies or caches.

21. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Poltorak in view of Levy as applied to Claim 1 and 5 above, and further in view of Danneels et al. (U.S. Patent No. 6,272,472; hereinafter Danneels).

With respect to Claim 11, Poltorak and Levy disclose the invention substantially as claimed. See the discussion of Claims 1 and 5 above. Poltorak and Levy do not explicitly teach providing all the executable instructions on a computer-readable medium. Danneels teaches a computer-implemented method realized as one or more programs on a computer (see Danneels, Column 2, Lines 40-46). In addition, Danneels teaches that the programs are storable on a computer-readable medium such as a floppy disk or a CD-

ROM (see Danneels, Column 2, Lines 46-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Poltorak in view of Levy discussed in Claims 1 and 5. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of distribution and installation and execution of the software on another computer (see Danneels, Column 2, Lines 46-49).

As to Claim 14, see discussion of Claim 11 above.

Conclusion

Although Examiner has cited particular columns, line numbers, and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore it must be noted that the documents cited on any enclosed PTO-892 or PTO-149 form are cited in their entirety.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685